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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

A-8919 (191930-1960)

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on _____

Signature _____

Typed or printed name _____

Application Number

10/602,987

Filed

June 25, 2003

First Named Inventor

Wasilewski, et al.

Art Unit

2131

Examiner

Chai, Longbit

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
 See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
 (Form PTO/SB/96)

☐ attorney or agent of record. _____
 Registration number _____

☒ attorney or agent acting under 37 CFR 1.34. _____
 Registration number if acting under 37 CFR 1.34 58169

/BAB/

Signature

Benjamin A. Balser

Typed or printed name

(770) 933-9500

Telephone number

October 26, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
 Submit multiple forms if more than one signature is required, see below*.



*Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Wasilewski, et al.

Serial No.: 10/602,987

Filed: June 25, 2003

Confirmation No.: 6302

Group Art Unit: 2131

Examiner: Chai, Longbit

Docket No.: A-8919 (191930-1960)

For: **Method for Partially Encrypting Program Data**

REMARKS IN SUPPORT OF
PRE-APPEAL BRIEF CONFERENCE

Mail Stop Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicant submits the following remarks in support of a Request for a Pre-Appeal Brief Conference.

REMARKS

Applicant submits that the following clear legal deficiency exists in the rejection. Namely, the previous final Office Action equates "selectively encrypting packets and using a PID to select packets for transmission" with "selecting for encryption a digital bit stream from a plurality of digital bit streams using an identifier," which are two functions that are known to be technically very different from each other. Additionally, the previous Office Action rejects the claims under 35 U.S.C. 112. Applicant has supplied an affidavit from an expert in support of its position that the claims are enabled.

I. Rejections of Independent Claim 1 Under 35 U.S.C. §103(a)

The Office Action rejects claim 1 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Wasilewski, et al.* (U.S. Patent no. 5,418,782). Applicant respectfully submits that independent claim 1 is allowable for at least the reason that the '782 patent does not disclose, teach, or suggest at least **using a packet identifier to select for encryption a portion of each of a plurality of digital bit streams from a transport streams**. Even if, assuming for the sake of argument, the '782 patent discloses that each type of stream is uniquely assigned a packet ID, the '782 patent fails to disclose using a packet identifier to select for encryption a portion of each of a plurality of digital bit streams from a transport streams. The '782 patent fails to disclose how the packets are selected *for encryption*. The Office Action alleges that the '782 patent makes it obvious to use the PID to select which packets are encrypted. In the '782 patent, the system could use some other method for selecting which packets to encrypt. For instance, any packet following an audio packet could be selected for encryption. Alternatively, every fourth packet could be selected for encryption. To allege that using a PID is obvious uses

impermissible hindsight. “Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness.” *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 53 U.S.P.Q.2d 1115, 1126 (Wash. 1999). Additionally, the Office Action must offer a reason that it would have been obvious to combine elements that are disclosed in the reference, but used for a different purpose. The Office Action fails to meet this requirement. Applicant does not dispute that a PID is disclosed in the reference. However, the PID is exclusively disclosed in the reference as a means to select packets for transmission. The ‘782 patent discloses **nothing** about how to select which packets are encrypted. Any allegation that using one particular means over many others must be considered hindsight reconstruction and is impermissible under the law. Therefore, the ‘782 patent does not disclose nor make obvious each element of independent claim 1, and the rejection should be withdrawn for at least that reason.

II. Rejections of Independent Claim 13 Under 35 U.S.C. §103(a)

The Office Action rejects claim 13 under 35 U.S.C. §103(a) as allegedly being unpatentable over *Wasilewski, et al.* (U.S. Patent no. 5,418,782). Applicant respectfully submits that independent claim 13 is allowable for at least the reason that the ‘782 patent does not disclose, teach, or suggest at least **using an identifier to select for encryption a portion of elementary bit streams from a plurality of programs**. Even if, assuming for the sake of argument, the ‘782 patent discloses that each type of stream is uniquely assigned a packet ID, the ‘782 patent fails to disclose using an identifier to select for encryption a portion of elementary bit streams from a plurality of programs. The ‘782 patent fails to disclose how the packets are selected *for encryption*. The Office Action alleges that the ‘782 patent makes it obvious to use

the PID to select which packets are encrypted. In the '782 patent, the system could use some other method for selecting which packets to encrypt. For instance, any packet following an audio packet could be selected for encryption. Alternatively, every fourth packet could be selected for encryption. To allege that using a PID is obvious uses impermissible hindsight. "Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness." *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 53 U.S.P.Q.2d 1115, 1126 (Wash. 1999). Additionally, the Office Action must offer a reason that it would have been obvious to combine elements that are disclosed in the reference, but used for a different purpose. The Office Action fails to meet this requirement. Applicant does not dispute that a PID is disclosed in the reference. However, the PID is exclusively disclosed in the reference as a means to select packets for transmission. The '782 patent discloses **nothing** about how to select which packets are encrypted. Any allegation that using one particular means over many others must be considered hindsight reconstruction and is impermissible under the law. Therefore, the '782 patent does not disclose nor make obvious each element of independent claim 13, and the rejection should be withdrawn for at least that reason.

CONCLUSION

For at least the reasons set forth above, favorable reconsideration and allowance, or the re-opening of prosecution on the merits of the present application and all pending claims are hereby courteously requested.

Respectfully submitted,

**THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, L.L.P.**

/BAB/

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